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November 27, 2007

David Saliwanchik

David R. Saliwanchik, Patent Attorney

COMMUNICATION
Examining Group *Not yet assigned*
Patent Application
Docket No. GJE-7555

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : *Not yet assigned*
Applicants : Donald James Highgate *et al.*
Serial No. : 10/568,241
Filed : February 4, 2006
Confirm. No. : 9552
For : Photovoltaic Cell

Mail Stop PCT
Commissioner for Patents
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Office of PCT Legal Administration

COMMUNICATION IN RESPONSE

TO DECISION ON PETITION UNDER 37 CFR 1.147(a)

Dear Sirs:

A Petition and Fee for a five month Extension of Time is being authorized with the electronic filing of this paper.

This Communication is being submitted in response to a Decision on Petition to File Application Without Signature of Joint Inventor dated April 27, 2007, copy attached.

On March 5, 2007 the applicants filed a Petition to File Application Without Signature of Joint Inventor. Specifically, the applicants had not been able to obtain the signature of (or even locate) co-inventor Lindsey Harrison.

The Decision on Petition dismissed the Petition and indicated that requirement 2 under 37 CFR 1.47(a) had not been satisfied. In order to satisfy requirement 2, the applicants are submitting herewith two statements of facts that are relied on to establish that a diligent effort has been made in trying to locate Ms. Harrison.

Attached herewith are executed Declarations from Rachel L. Smith and Robert E. Perry stating the facts regarding the efforts made to locate inventor Harrison.

Ms. Smith is Head of Science at ITM, which is the assignee of the subject application. As described in detail in Ms. Smith's Declaration, diligent efforts to locate Ms. Harrison have been made by mail, personal inquiry, telephone directory and internet searches.

Mr. Robert E. Perry, is an European Patent Attorney with the firm Gill Jennings & Every LLP located in London, England, which represents ITM, the assignee of the application. As noted in Mr. Perry's Declaration, diligent attempts have been made to locate Ms. Harrison without success.

In view of the Declarations of Ms. Smith and Mr. Perry, the applicants respectfully request reconsideration of the Decision on Petition to File Application Without Signature of Joint Inventor.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

Respectfully submitted,



David R. Saliwanchik

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DRS/la

Attachments: Executed Declaration of Ms. Rachel L. Smith
Executed Declaration of Mr. Robert E. Perry

Patent Application
Docket No. GJE-7555
Serial No. 10/568,241

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Donald James Highgate *et al.*
Serial No. : 10/568,241
Filed : February 14, 2006
Art Unit : Not yet assigned
For : Photovoltaic Cell

Commissioner for Patents
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DECLARATION OF RACHEL L. SMITH

Sir:

I, Rachel L. Smith, make this declaration based on my personal knowledge and belief:

1. I am Head of Science of the assignee of the Application ("ITM") and located in Sheffield, England. I am responsible, within ITM, for intellectual property matters.

2. By way of background, Lindsey Harrison was taken on by ITM in 2003 while an undergraduate at Sheffield University, for a summer project. Following some interesting results, which included her inventive contribution to this Application, and a good working relationship, it was intended that Lindsey Harrison would start a Ph.D. for ITM after completing her degree (her final year project was for ITM). However, she never arrived. Attempts to contact her by calling her mobile phone were made by personnel at ITM a number of times without any answer and without any reply to the messages that were left.

3. On or about August 2004, I contacted her degree supervisor at Sheffield University,

who told me that although Lindsey Harrison had obtained a first class degree, she never attended her graduation, that the University were also unable to contact her, and that he had not heard from her since, although he did think that she had signed up to do a Ph.D. at Manchester University.

4. Following a request from Gill Jennings & Every LLP, the firm of patent attorneys acting for ITM, to get Lindsey Harrison to sign a Declaration and an Assignment for this Application, in February 2006, I tried to track her down again. Looking at the research site at Manchester University and also Google, I found a profile on Friends Re-united that matched what I knew of her, and I sent her the following message on 9th February 2006:

"Hi Lindsey,

I hope I have the right person, please email me to let me know if you are the Lindsey who did a STEP placement with us a few years back. If you are not none of this will make any sense to you at all, sorry.

If you are, I'm glad we found you, we have been trying to find you for ages, you went without a trace, we were worried, I hope everything was okay. I hear you got a 1st, well done.

ITM has gone from strength to strength, we employ about 15 more scientists now. Simon, Matt and I are still here too. We floated on the stock exchange almost 2 years ago and the price is still going up so we must be doing something right!

Not only would we love to hear from you, I also have some papers I would like you to sign to do with the PV patent.

Please get in touch

rls@itm-power.com

0114 2422223

On a personal level I am now a mum of one (Tabitha ages 3 months) and Simon has two (Harris and Evylen), and Matt has a Harley Davidson instead!

Hope to hear from you soon

Rachel"

I received no reply.

5. I sent the following message on 13th April 2006:

"Hi Lindsey,

I emailed you a few weeks ago now via this site, but don't know if you received my letter.

I am not sure if you are the right Lindsey or not, please can you reply and let me know if you are the ITM Step Lindsey or not.

Cheers

Rachel"

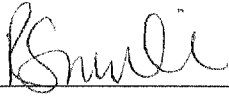
Again, I received no reply.

6. The profile on Friends Re-united was last updated on 17th March 2006, and I therefore believe that the first message must have been received when the recipient logged on. The profile gives no indication of where she is living, and only that she is doing a Post Graduate Certificate in Education following dropping out of a Ph.D. course.

7. I have been unable to locate Lindsey Harrison in any telephone directory. All efforts to find new contact information have been to no avail.

8. I have made diligent efforts to locate Ms. Harrison. However, all attempts to locate Ms. Harrison have been unsuccessful.

I hereby further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

By: 

Date: 21/11/07

Patent Application
Docket No. GJE-7555
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DECLARATION OF ROBERT E. PERRY

Sir:

I, Robert E. Perry, make this declaration based on my personal knowledge and belief:

1. I am a European patent attorney with the firm Gill Jennings & Every LLP located in London, England. The firm represents the assignee of this Application ("ITM") in intellectual property matters.

2. On or around May 8, 2006, I prepared and sent a letter to Ms. Lindsey Harrison wherein I enclosed a copy of the specification of this Application (including the claims) and a Declaration/Power of Attorney form and an Assignment document for execution by Ms. Harrison. The letter was sent by Royal Mail courier service to Ms. Harrison's last known address (115 Gell Street, Sheffield, S3 7QT, United Kingdom).

4. On or around May 10, 2006, Royal Mail returned the mail package to me (as sender) with an explanation that the mail item was undeliverable because the "addressee has gone away". The mail deliverer further notated on the returned mail item that the addressee was "no longer at this address". Enclosed are copies of the envelope and enclosed documents that were sent to Ms. Harrison at her last known address (115 Gell Street, Sheffield, S3 7QT, United Kingdom) via the Royal Mail service.

5. Further, ITM has made diligent efforts to locate Ms. Harrison. I understand that all attempts to locate Ms. Harrison have been unsuccessful.

I hereby further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

By: 

Date: 23 November 2007

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

INVENTOR CANNOT BE REACHED:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under **37 CFR 1.47**, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under **37 CFR 1.47**.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under **37 CFR 1.47**. **37 CFR 1.43** may be available under these circumstances. See **MPEP § 409.02**. Such a petition under **37 CFR 1.47** will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioner has satisfied requirements (1), (3) and (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

The averments of Mr. Saliwanchik are insufficient to support a finding that the nonsigning inventor, Ms. Harrison could not be found after diligent effort. The petition states that in an effort to locate Ms. Harrison, an ITM employee placed several calls to her personal mobile phone to no avail. However, this is insufficient to satisfy requirement 2.

Consequently, Mr. Saliwanchik fails to show diligent effort to locate inventor Ms. Harrison because no proof to corroborate his actions that Ms. Harrison could not be reached after diligent effort has been provided. For example, he has not shown that he has searched for the above non-signing inventor's new address by using a broad search in the internet or by using a phone director to try to locate Ms. Harrison's new address.

Moreover, it is not clear from the petition that it was Mr. Saliwanchik who performed the items listed in the petition, and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Mr. Saliwanchik was not the person who performed the actions listed in petition, petitioner will need to submit statements, with specific facts on the actions referred to in the petition by persons who have first-hand knowledge of such facts.

Accordingly, at this time it can not be concluded that the nonsigning Ms. Harrison could not be reached after diligent effort as stipulated under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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